

### **REMARKS/ARGUMENTS**

The Applicants respectfully request reconsideration of the present application in light of the amendments made to the application and the following remarks, which are responsive to the Office Action mailed March 24, 2005. Claims 1-34 are pending in the application.

The Applicant will generally respond to the Official Action in the general order in which it was presented.

#### **A. Information Disclosure Statement**

Examiner has correctly identified U.S. Patent Number 5,677,834 issued to Mooneyham as the reference intended to be disclosed by Applicants. Applicants apologize for the typographical errors in the listing of the reference on Form PTO 1449 as U.S. Patent Number "5,667,834" and indicating the patent was issued to "Monneyham" rather than "Mooneyham."

#### **B. Double Patenting Rejection**

The Office Action rejects claims 1-34 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 13-32 of U.S. Patent No. 6,634,551 (hereinafter "the '551 patent"). Applicants have amended the specification to clarify that the current application is a continuation-in-part of and claims priority from the '551 patent. In addition, Applicants respectfully submit a terminal disclaimer pursuant to MPEP § 804.02 and 37 CFR 1.130(b) in order to obviate the double patenting rejection. The terminal disclaimer can be found in the Appendix at the end of this response.

#### **C. Specification Objection**

The Office Action indicates that the specification is objected to because of several informalities. As may be seen, the Applicants have requested that the paragraph on page 14, lines 11 through 19, be amended. These amendments are as follows. At page 14, line 15 of the

specification, Applicants have deleted 70 and replaced it with --20--. At page 14, line 17 of the specification, Applicants have deleted 71 and replaced it with --21--.

#### **D. Claim Objections**

The Office Action indicates that Claim 3 is objected to based on an informality (i.e., that Claim 3 is an exact duplicate of Claim 2). As may be seen, the Applicants have amended Claim 3 to clarify that one delivery notice code is read and then a plurality of item codes are read, then the plurality of item codes are linked with the delivery notice code, which distinguishes Claim 3 from Claim 2.

#### **E. Claim Rejections – 35 U.S.C. § 103 – Claims 1-5, 10-12, 18-31, and 33**

##### **1. The Rejection**

In the Official Action, Claims 1-5, 10-12, 18-31, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Monico* (U.S. Patent No. 6,021,942) in view of *Gulick* (U.S. Patent No. 5,362,949).

The Office Action provides in part that:

**“In view of the teaching of Gulick, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the barcode condensing system of Gulick to the package delivery service of Monico because having one barcode that can access information for a plurality of items is favorable because in this way the plurality of delivery notices will not be misplaced and the labor intensive shipping labels can be avoided. In addition, the information will be stored in a centralized database that will keep all of the information together. It is appropriate to combine these references because in combination they teach the invention of linking the plurality of delivery notices together, wherein Monico teaches the scanning and storing of the delivery codes and Gulick teaches the condensing of identifying information into one barcode.”**

2. The *Monico* Reference

The invention disclosed in *Monico* is directed toward a three-part delivery notice having a first section, a second section and a third section. The third section is a first delivery attempt notice, the second section is a second delivery attempt notice, and the first section indicates a reason for delivery failure (reference FIG. 1 of the patent). Each portion of the three-part delivery notice in *Monico* has machine-readable and human-readable indicia. Unlike the present invention, common indicia are used on each section of the delivery notice in *Monico*. *Monico* reads as follows at column 5, lines 1-42:

“The **first section 21** typically includes identification indicia shown generally by reference 33 in FIG. 1, and including a machine-readable (e.g. bar code) part 34, and a human-readable part 35. The first section 21 also comprises a plurality of (at least two, and preferably at least three) reason for non-delivery indicia. These indicia all include a machine-readable (e.g. bar code) part 36 and a corresponding human-readable part 37. The particular reason for non-delivery indicia illustrated in FIG. 1 include “wrong address”, “consignee moved”, “consignee not at home”, “office closed”, “damaged”, “refused delivery”, “not delivered (no time)”, “wrong route”, and “other”. The “other” indicia is followed by lines 38 facilitating the entry of handwritten information. The above reasons for non-delivery are exemplary only and different or other wording and/or reasons may be provided. The **third section 23**, which may be connected directly to the first section 21 if the second section 22 is not provided, preferably **includes indicia 133 in common with the indicia 33 (except having an extender indicating the first attempt at delivery)**. This includes a machine-readable part 134 and a human-readable part 135, with the extenders 40, 41. The indicia imaged on the third section 23 also preferably includes human-readable indicia 42 (e.g. “first attempt”) indicating a first attempt to deliver a package, and preferably also includes a toll-free telephone number indicia 43 to call if an indicated redelivery time is inconvenient, to request redelivery, and/or for questions, and one or more blank areas 44 for the entry of handwritten indicia indicating potential other delivery dates or times. Also there may be indicia 45 indicating that if the addressee/consignee would like the package merely left at the door that he or she can sign at the indicia 46 and on the next delivery the package will merely be left at the door. Other suitable indicia also may be provided, as illustrated in the example in FIG. 1.

The second section 22 also includes identification indicia 233, but with a different extender 240, 241, the indicia 233 – except for the extender – in common with the indicia 33, 133.” (Emphasis in boldface type added.)

Therefore, *Monico* only teaches that the identification indicia (e.g., barcode) on the first, second and third sections of the label are common, except for the extender used to identify the second and third sections. The extender is used to identify whether the delivery attempt is a first delivery attempt or a second delivery attempt. When a first attempted delivery is unsuccessful, the identification indicia on the first section is scanned as well as a barcoded reason for non-delivery. One section (section three) of the three-part delivery notice is separated from the three-part notice and is left at the addressee's location. The remaining sections are affixed to the package. The common identification indicia with its extender on the section of the label that is left at the addressee's location may be scanned to determine whether the delivery attempt was a first or second delivery attempt. The second section of the label may be left at the delivery location if another unsuccessful delivery attempt occurs. Note that the identification indicia (e.g., bar-code) on all three sections of the *Monico* delivery notice are common identification indicia.

Stated simply, there can be *two* delivery notices each bearing the *same* indicia left at an addressee's location for the *same* package.

In contrast, Applicants' invention discloses that a **single** delivery notice with a delivery notice code may be linked to a **plurality** of packages with each package having a **different** package code thereon. In one preferred embodiment, the package code is a "tracking number" used by commercial delivery services for tracking parcels. Each package code is unique:

"As shown in Fig. 2, the exemplary package 110 includes a machine-readable package code 111 (a.k.a. "item code"), which in one embodiment is a "tracking number" or "1Z" number as referenced by United Parcel Service, although obviously other package codes used to track or identify packages may also be used." (Applicants' specification, page 10, lines 23-26.)

And:

"It will be assumed that two parcels 110, 120, are to be delivered, with each parcel including a different machine-readable parcel code (a.k.a. "item code") readable therefrom." (Applicants' specification, Page 13, lines 10-12.)

As will be discussed further below, in the Applicants' invention, the package code is not "affixed" on a package by an adhesive as a section or sections of a multi-section form, as is taught by *Monico*, nor is the package code "common" with the delivery notice code. In contrast,

in the Applicants' invention, the delivery notice code may be "linked" to the package codes of a plurality of packages.

3. The *Gulick* Reference

The Office Action provides that "[r]egarding claims 1-5, 10-12, 18-31, and 33, *Monico* fails to teach that there the [sic] delivery notice codes are linked to the item codes" and cites *Gulick* to form an obviousness-based rejection.

*Gulick* teaches a packing house control system. Specifically, *Gulick* discloses the use of a single machine-readable label (e.g. barcode) to represent multiple items of information rather than using a separate machine-readable label for each item of information. *Gulick* teaches the association of multiple items of information to one barcode label. *Gulick* discloses that:

"In the prior art, when up to three or four labels with various codes are placed on the carton, there is always the chance that the carton may be removed from the conveyor line prior to reaching the scanning device, thereby losing all track of the packed carton.

In this invention, the packed boxes, **bearing one coded label**, pass from the packing unit 10 on a conveyor 14 to a scanner reading station 16." (Col. 5, lines 48-55, emphasis in boldface type added.)

And, that:

"In the prior art as known at this time, more than one code label must be placed on each box in order to guide the box through the system and provide information concerning the box." (Col. 6, lines 24-27.)

Therefore, unlike the Applicants' invention, it can be seen that *Gulick* teaches the combination of separate information items that in the prior art were each associated with their own barcode into a single barcode reflective of the aggregated information. *Gulick* does not teach linking one barcode to a plurality of different barcodes.

4. Applicants' Response

Claim 1 of the Application is reproduced below for clarity and reference in the following discussion:

1. (Original) A method for delivering a **plurality of unique items** each having a **unique identity** and having a **different item code readable therefrom**, said method including the steps of:

- A) providing a plurality of delivery notices, each of said delivery notices including a delivery notice code thereon, each of said delivery notice codes being unique within said plurality of delivery notices;
- B) reading said delivery notice code from one of said delivery notices;
- C) reading said item code from each of said items; and
- D) linking said delivery notice code with said item code from each of said items.**

The Applicants' invention materially differs from *Monico* in several aspects. In *Monico* there is no need to link the identification indicia on the section that is left at the addressee's location (i.e., delivery notice) with the identification indicia on the sections that are affixed to the package (i.e., package code) because each section has common identification indicia. Applicants' invention discloses the linking of a unique delivery notice code with a plurality of unique items each having a different item code.

Referencing Claim 1, above, an element of the claim requires reading the delivery notice code and the item code. If the delivery notice code and the item code were in common, as they are in *Monico*, there would be no need to read both codes. There is no requirement for commonality between the delivery notice code and the package codes in the Applicants' invention. Applicants' use of a delivery notice code that is not common with the item codes of a plurality of items allows each package in such plurality to be separately identified, tracked and manipulated. Furthermore, unlike the Applicants' invention, *Monico* teaches affixing a portion of the delivery notice to the package to provide a readable indicia on the package. The

Applicants' invention utilizes pre-existing item codes that are used to track or identify the package.

The Office Action provides that, "*Monico teaches a bar-coded label for 'attempt to deliver' parcels.*" This itself is true, but the Applicants are not claiming the general use of bar codes with "attempt to deliver" parcels.

Applicants respectfully submit that *Monico* teaches a multi-section bar-coded label for "attempt to deliver" parcels having a common bar-code on all sections of the label with one section left at the addressee's location as a delivery notice and the remaining sections affixed to the package. *Monico* fails to teach or suggest a unique delivery notice code on a delivery notice linked with tracking numbers (package codes) on a plurality of packages wherein the delivery notice code and the tracking numbers are not common.

Applicants respectfully submit that *Gulick* teaches the combination of separate information items that in the prior art were each associated with their own barcode into a single barcode reflective of the aggregated information. Significantly different than *Gulick*, the Applicants' invention links one delivery notice code to an item code of a plurality of items. Claim 1 of the Application requires reading a delivery notice code from one of said delivery notices and reading an item code from each of said plurality of items, such that a delivery notice code is read and a plurality of item codes are read. The present invention is not directed toward the consolidation of barcodes or the consolidation of information represented by a multitude of barcodes into information represented by only one barcode as is found in *Gulick*.

Applicants respectfully submit that it would not have been obvious to one of ordinary skill in the art at the time of the invention to modify *Monico* in view of the teaching of *Gulick* to arrive at the Applicants' invention. The Examiner submits, "[i]t is **appropriate to combine these references because in combination they teach the invention of linking the plurality of delivery notices together, wherein *Monico* teaches the scanning and storing of the delivery codes and *Gulick* teaches the condensing of identifying information into one barcode.**" However, the present invention links one delivery notice to a plurality of items, it does not link a "plurality of delivery notices together." Furthermore, the present invention links the code on a single delivery notice to unique codes on a plurality of items. It does not require fewer or consolidate codes. In fact, it may require additional codes because the pre-existing codes on

packages used for tracking purposes are linked to another different code on a delivery notice. The link is between the code of the delivery notice and the unique codes of the items, it is not a means of “condensing identifying information into one barcode.”

Therefore, it is respectfully submitted that *Monico* and *Gulick*, separately or in combination, do not teach or suggest the present invention. Moreover, because *Monico* teaches the use of one common barcode on the delivery notice and the package, and *Gulick* teaches consolidating a multitude of barcodes into one barcode, there is no suggestion to modify *Monico* in view of *Gulick* and it would not have been obvious to one of ordinary skill in the art at the time of the invention to modify *Monico* in view of *Gulick*.

Accordingly, Applicants respectfully submit that independent Claims 1-5, 10-12, 18-20, and 27-30, and their respective dependent claims (namely claims 21-26, 31, and 33) are all patentable, each on its own merits, over the combination of *Monico* and *Gulick*. Claims 1-5, 10-12, 18-20 and 27-30 are method claims directed toward a method for delivering a plurality of unique items each having *unique identities* and each having a *different* item code thereon and a delivery notice with a delivery notice code thereon. Again, as set forth above, it is respectfully submitted that the combination of *Monico* and *Gulick* does not suggest such a method and these claims are allowable. Claims 21-26, 31, and 33 depend from these allowable independent claims and are also submitted to be allowable on their own merits.

#### **F. Claim Rejections – 35 U.S.C. § 103 – Claims 6, 13-17, 32 and 34**

##### **1. The Rejection**

In the Official Action, Claims 6, 13-17, 32 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Monico* as modified by *Gulick* and further in view of *Knowles et al.* (U.S. Patent No. 5,869,819, hereinafter “*Knowles*”). The teachings of *Monico* as modified by *Gulick* have been discussed above.

The Office Action provides in part that:

**“In view of the teaching of Knowles, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ**



**an internet connection for transmitting data because it is well known in the art that the internet is a reliable, convenient, and safe way to transmit data.”**

2. The Knowles Reference

*Knowles* discloses in its Abstract:

“A novel Web-based package routing, tracking and delivering system and method that uses URL/ZIP-CODE encoded bar code symbols on parcels and packages. The system comprises one or more Routing, Tracking and Delivery (RTD) Internet Server Subsystems connected to the Internet infrastructure and updated at any instant of time with package tracking information. A Package Log-In/Shipping Subsystem is located at each shipping location and connected to the RTD Internet Server by way of the Internet infrastructure. A Package Routing Subsystem is located at a hub station and connected to the RTD Internet Server by way of the Internet infrastructure. A Portable Package Delivery Subsystem is carried by each package delivery person, and connected to the RTD Internet Server by way of the Internet infrastructure communication link. At each remote hub station within the system, the URL/ZIP-CODE encoded bar code symbol is automatically scanned by way of the Internet infrastructure; the encoded destination Zip Code is locally recovered and used to route the package at the hub station; and the locally recovered URL is used to access the RTD Internet Server and update the location of the package within the system. The Portable Package Delivery Subsystem is used to read the URL/ZIP-CODE encoded bar code symbol near the delivery destination in order to access the RTD Internet Server and display delivery information and the like to facilitate the delivery process.”

Applicants respectfully submit that generally, *Knowles* discloses systems and methods for package-tracking that utilize a specialized bar-code that includes an Internet uniform resource locator (“URL”). Each parcel or package has an Internet website established such that the package may be tracked by scanning the URL-encoded barcode at various locations throughout the delivery process and updating the package’s website. Other information, such as delivery instructions may also be included on the website and may be accessed by a delivery person using a portable scanner with Internet access.

3. Applicants' Response

It is stated in the Office Action that *Monico* as modified by *Gulick* fails to disclose that an Internet connection is used for receiving data and cites *Knowles* for that element. However, Applicants respectfully submit that *Knowles* teaches an Internet-based system and method for tracking objects bearing URL/ZIP-encoded bar code symbols. The Office Action concedes that **“*Knowles* teaches an internet-based system and method for tracking objects bearing URL-encoded bar code symbols.”**

As noted above, Applicants submit that neither *Monico* nor *Gulick*, separately or in combination, teach or suggest the present invention. Therefore, the addition of *Knowles* with its teaching of “an internet connection for transmitting data” adds little, if anything, in forming a combination that would have been obvious at the time of the invention. *Knowles* does not teach the transmission of information linking the indicia of a delivery notice to indicia on a plurality of packages (“item codes”) as is disclosed in the Applicants’ invention. The “item codes” of the present invention are tracking numbers (i.e., “1Z” numbers), not specialized URL/ZIP-encoded bar code symbols as is disclosed in the *Knowles* patent.

Claims 32 and 34 of the Application are dependent claims that depend from claims that are allowable based on the above argument concerning the *Monico* – *Gulick* combination. These dependent claims add the element of utilizing the Internet as a medium to contacting the delivery service and providing instructions from an intended recipient. They do not teach or suggest providing access to a specific URL regarding a particular parcel, as is taught in *Knowles*.

Claims 6 and 13 are independent claims that include as elements contacting the delivery service through the Internet, and providing an Internet website that may be accessed by the intended recipient of an item, respectively. Claims 14-17 depend from the base Claim 13 and do not address Internet access. As provided above, these claims merely add the element of utilizing the Internet as a medium to contact or access the delivery service. They do not teach or suggest providing access to a specific URL regarding a particular parcel, as is taught in *Knowles*. Because dependent Claim 14-17 do not concern Internet access, they are allowable as the base Claim 13 is distinguished from *Monico* and *Gulick* in view of *Knowles*.

Therefore, Applicants respectfully submit that independent Claims 6 and 13 and dependent Claims 32 and 34 are patentable on their own merit over the combination of *Monico*

and *Gulick* in view of *Knowles*, and that dependent Claims 14-17, which depend from allowable independent Claim 13 are likewise in a form for allowance.

### **G. Claim Rejections – 35 U.S.C. § 103 – Claims 7-9**

#### **1. The Rejection**

In the Official Action, Claims 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Monico* as modified by *Gulick* and further in view of *Tuttle* (U.S. Patent No. 5,497,140, hereinafter “*Tuttle*”). The teachings of *Monico* as modified by *Gulick* have been discussed above.

The Office Action provides in part that:

**“In view of the teaching of Tuttle, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the use of RFID tags as the delivery notice because an RFID tag is an efficient means of storing and transmitting data (i.e., the RFID tag is portable, secure, compact, and it is easy to read data from it). In addition, a delivery notice is within the same genre of a shipping/packing label, hence it is obvious to employ a delivery notice in addition to the labels as taught by Tuttle.”**

#### **2. The Tuttle Reference**

*Tuttle* provides at Col. 2, lines 24-44 that:

**“To accomplish the above purpose and object, there have been developed both an electrically powered postage stamp and an electrically powered mailing label, each of which include, in combination, an integrated circuit chip having an RF transceiver constructed therein; a thin flat battery cell connected to the IC chip for providing power thereto; and a thin film RF antenna connected to the IC chip for transmitting data to and from the IC chip. All of the above components are connected in a very thin array and mounted between opposing major facing surfaces of either a postage stamp or a larger mailing or shipping label in a substantially two dimensional planar configuration. These components are operative to store data in the IC chip memory, which data includes such things as the destination address, return address, and descriptions of the contents of the article being mailed or shipped. These components are further operative in a novel system combination to transmit the stored data to an interrogating party upon receipt of**

RF interrogation signals transmitted to the stamp or label, or to receive data from same.”  
(Emphasis added in bold.)

Applicants respectfully submit that generally, *Tuttle* discloses a miniature radio frequency identification transceiver. Applications of the transceiver that are disclosed in *Tuttle* include the use of the transceiver as an electrically power postage stamp and an electrically powered mailing label. Information stored on the transceiver, according to *Tuttle*, may include the destination address, return address, and description of the contents of the article being mailed or shipped.

3. Applicants' Response

It is stated in the Office Action that *Monico* as modified by *Gulick* fails to teach that the delivery notice is an RFID tag. However, Applicants respectfully submit, and as is conceded in the Office Action, that **“*Tuttle* teaches an electrically powered postage stamp or mailing/shipping label.”**

As noted above, Applicants submit that neither *Monico* nor *Gulick*, separately or in combination, teach or suggest the present invention. *Monico* teaches only the use of multiple delivery notices having the same delivery codes and *Gulick* teaches only that each item code is consolidated into one barcode for scanning, which does not teach the limitations of the present invention. Therefore, the addition of *Tuttle* with its teaching of “an electrically powered postage stamp or mailing/shipping label” adds little, if anything, in forming a combination that would have been obvious to one of ordinary skill in that art at the time of the invention. *Monico* as modified by *Gulick* and further in view of *Tuttle* fail to teach or suggest the linking of a unique item code with a unique delivery notice code, and the combination of *Monico*, *Gulick* and *Tuttle* would not have made this linking aspect obvious to one of ordinary skill in the art at the time of the invention.

Claims 7 and 9 require a delivery notice comprised of an RFID tag that has a unique delivery notice code encoded thereon which is linked with an item code that is found on an item. The Office Action provides that **“a delivery notice is within the same genre of a shipping/packing label, hence it is obvious to employ a delivery notice in addition to the labels as taught by *Tuttle*.”** Respectfully, Applicants reject this assertion as it would be no

more obvious to use an electrically powered shipping/packing label as a delivery notice as using a standard (alphanumeric) shipping/packing label as a delivery notice. While a delivery notice may be linked to a shipping/packing label and the information that is contained on such a shipping/packing label, the delivery notice of the invention does not duplicate the information of a shipping/packing label. *Tuttle* does not teach or suggest the storing of a unique delivery notice code on each RFID device used as a delivery notice, where such unique delivery notice code may be linked to codes associated with a plurality of packages ("item codes") as is disclosed in the Applicants' invention.

Furthermore, as described in *Tuttle*, the information that may be contained in the transceiver includes the destination address, return address, and description of the contents of the article being mailed or shipped. Generally, and as shown in the embodiment illustrated in FIGS. 3A and 3B of the Application, a delivery notice contains information about an attempted delivery of one or more parcels, and where or how the parcels may be obtained by the customer. There is no information about the destination address, the return address, or the contents of the parcels as is taught by the shipping/packing label of *Tuttle*. *Tuttle* does not teach or suggest the use of an RFID tag as a delivery notice, nor would it have been obvious to one of ordinary skill in the art at the time of the invention to do so, even if combined with *Monico* and *Gulick*.

Claim 8 requires reading the item code from the item where the item code is encoded on an RFID tag, and linking the delivery notice code from a delivery notice with the item code. While *Tuttle* contemplates associating an RFID tag with an item as a mailing label or postage stamp, it does not teach or suggest encoding such an RFID tag with an item code nor would it make obvious the linking of the delivery notice code with an item code where the item code is encoded on an RFID tag.

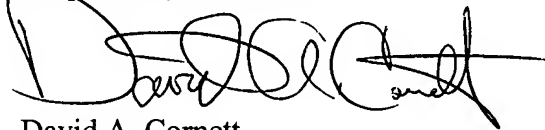
Therefore, Applicants respectfully submit that independent Claims 7-9 are patentable on their own merit over the combination of *Monico* and *Gulick* in view of *Tuttle*.

**H. Conclusion**

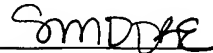
After this amendment, Claims 1-34 remain pending in this application. Applicants respectfully submit that all pending claims are patentably distinguishable over the prior art of record, and therefore, are in condition for allowance.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,



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